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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/341,241 09/14/99 DUPUIS

C 2350-73

EXAMINER

HM12/1023

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SHARAREH, S

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

10/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/341,241

Applicant(s)

DUPUIS ET AL.

Examiner

Shahnam Sharareh

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1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment filed on August 8, 2001 has been entered. Claim 15-28 are now pending.

Response to the Amendments and Arguments

Any rejection that was made in the Office Action filed on May 8, 2001, Paper No. 9, and not addressed in this Office Action is considered obviated in view of the Amendments.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 15-28 stand rejected under 35 U.S.C. 102(e) as being anticipated by Almaric et al US Patent 5,670,471.

Applicant's arguments with respect to this rejection have been fully considered but are not found persuasive. Applicant argues that Almaric does not teach the instant non-ionic type surfactants in proportion of less than 1% by weight with respect to the total weight of the composition.

In response Examiner states that during patent examination, the pending claims are "given their broadest reasonable interpretation consistent with the specification." MPEP 2111. The recitation of the instant claims encompasses formulations comprising at least one non-ionic surface-active agent in claimed proportions. Further, the instant specification describes the scope of non-ionic surfactants in pages 4, lines 16-37. Accordingly, any alcohols, alkyl phenols or fatty acids, glycerol derivatives, and alkyl polyglycosides or esters thereof can act as a suitable non-ionic surfactant.

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Almaric clearly describes preparations of alkylglycoside containing concentrates comprising Dodecanol at 0.3%, Tetradecanol at 1.65%, Dodecylpolyglycosides at 14.4% etc...(see col 6). Almaric further uses 4% of said concentrates in his final mixture in combination with Acrysol 22 within about 2-3 wt% of the total composition (Acrysol is a (meth)acrylic acid/ ethyl acrylate/ polyoxyethyleneated stearyl methacrylate copolymer see col 5, line 54, col 12, lines 61-67), and a conditioning agent. Accordingly, Almaric's compositions comprise at least one non-ionic surfactants in the claimed ranges and claims 15-28 are properly rejected.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case, claim 15 recites the limitation "non-crosslinked acrylic copolymer having a $C_8 - C_{32}$ hydrophobic chain," which was not disclosed in either the specification nor the claims of the instant application as originally filed. Although the parent applications described the use of various hydrophobic chain lengths, such hydrophobic chains having $C_{23} - C_{32}$ was never described in the subgenus of "hydrophobic chains" in the original specification.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guerrero et al US Patent 5,236,710 in view of Almaric et al US Patent 5,670,471.

Guerrero et al disclose cosmetic compositions comprising non-crosslinked copolymers of acrylic type with a hydrophobic chain (see col 2-3, example 1). Guerrero also teaches that acrylic copolymers may have longer chains upto C 30 (col 3, line 40-45). Guerrero further discloses the use of various optional emollients such as stearyl alcohol etc (co 4, lines 35-60) which encompass the instant non-ionic surfactants. Guerrero also teaches the use of at least one insoluble conditioning such as silicone surfactants agent (see abstract, col 3, col 4 lines 30-67, example 1). Guerrero fails to teach the use of an non-ionic surfactant in the instantly claimed ranges.

Almaric teaches use of suitable amounts of a non-ionic surfactant in cosmetic compositions. Specifically, Almaric describes preparations of alkylglycoside containing concentrates comprising Dodecanol at 0.3%, Tetradecanol at 1.65%, Dodecylpolyglycosides at 14.4% etc...(see col 6) which is contained in the final composition in less than 1% of the total weight.

Although, Guerrero fails to use a non-ionic surfactant in his composition, it would have been obvious to one of ordinary skill in the art at the time of invention to further add a non-ionic surfactants to Guerrero's composition in amounts taught by Almaric, because the ordinary artisan would have had a reasonable expectation of success in improving beneficial characteristics of the his compositions such as skin tolerance and

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plasticity. Further, absence of showing a criticality, modifications of the concentration ranges of a cosmetic composition would not impart patentability.

Conclusion

No claims are allowed. Applicant's amendment has modified the scope of the claims, thus, necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnam Sharareh whose telephone number is 703-306-5400. The examiner can normally be reached on 8:30 am - 6:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

ss

October 22, 2001



DIANA DUDASH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600